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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,432	01/05/2001	William A. Bachovchin	TUU-P02-006	3173

28120 7590 05/22/2003

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EXAMINER

RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 05/22/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/601,432

Applicant(s)

BACHOVCHIN ET AL.

Examiner

Jeffrey E. Russel

Art Unit

1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-14 and 16-37.

Claim(s) withdrawn from consideration: _____.

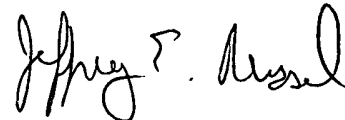
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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1. The proposed amendment filed May 14, 2003 will not be entered because of the following errors in amendment format: The amendment to the specification was not submitted in the form of a replacement paragraph. The text to be added to claim 4, page 9, line 15, is not underlined. Claim 11 is stated to be a previously amended claim; however, there is a strike-out in the claim, which indicates that it is being amended.
2. The proposed amendment filed May 14, 2003 will not be entered because it raises the following new issues: At proposed claim 1, line 1, "reducing" is misspelled. The proposed amendment to the preamble of claim 2 ("improving glucose tolerance") raises new issues under 35 U.S.C. 112, second paragraph, with respect to claim 7 ("reduces... glucose intolerance"). To the extent that claim 7 is dependent upon claim 2, it is not clear if the limitation of claim 7 is automatically satisfied when claim 2 is taught or suggested by the prior art, or if claim 7 presents alternatives to the results required by independent claim 2. Claim 16 recites that Y_1 and Y_2 can be OH, a possibility not permitted by the definition of Y_1 and Y_2 in claims 1, 2, and 4. At proposed claim 2, page 7, line 2, and proposed claim 4, page 9, line 14, "or" should be deleted. The proposed amendment to claim 28 raises new issues requiring further consideration and/or search, because compounds having the recited structure have not previously been claimed before. See also the final Office action, page 8, last paragraph.
3. The proposed amendment after final rejection filed May 14, 2003 did not address the objection set forth in paragraph 4 of the final Office action with respect to claim 28, page 16, line 4, and claim 31, page 19, line 7.

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4. The provisional obviousness-type double patenting rejection set forth in paragraph 6 of the final Office action would be maintained against the claims as amended in the response filed May 14, 2003.
5. The examiner maintains his position with respect to inherency and the rejections over the WO Patent Application '309 and WO Patent Application '259. The proposed amendments filed May 14, 2003 would have overcome the rejections over Villhauer and over the German Patent '486. Proposed new claim 38 would be novel and unobvious over the prior art of record, although it would be subject to the same provisional obviousness-type double patenting rejection set forth in the final Office action.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (703) 306-3220. The fax number for Art Unit 1654 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.



Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1654

JRussel
May 20, 2003